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Supreme Court, U.S.
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No. _____

In The

Supreme Court Of The United States

OCTOBER TERM, 1988

LEONARD J. JULIEN,
Petitioner,

v.

HENRY ZERINGUE, ZERINGUE'S FARM EQUIPMENT SERVICE, and JOHN CLET LANDRY; and

THOMSON INTERNATIONAL, INC., LABADIEVILLE MACHINERY CO., INC., and ROBERT BOUDREAUX,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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IN THE U.S. SUPREME COURT

October Term 1988

No.

Julien v. Zeringue et al

On Petition for Writ of Certiorari

***ERRATA* SHEET for Petition**

Page 29, line 6,	"this Court" should be -- the CAFC --.
Page 63, FN 58,	"some" should be -- small --.

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QUESTIONS PRESENTED FOR REVIEW

- Patent Related Questions -

1. When an invention is held to be a "pioneering" one, does the doctrine of equivalence as established by this Court in Graver[1] and Miller[2] require that a court give consideration to the scope or breadth of equivalence to be accorded to such a pioneering invention in evaluating an infringement of the patent?

2. Is the approach under the judicially defined doctrine of equivalence to be the micro view of "every claim limitation," as espoused by the appeals court, or the macro approach of considering the "device" (as a whole), as stated by this Court in Graver?

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[1]Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 607; 85 USPQ 328, 330 (1950).

[2]Miller v Eagle Manufacturing Co., 151 U.S. 186 (1894).

3. Did the appeals court's premature decision initially holding the appeal to be "frivolous" before the appeal process could be completed, and its subsequent decision reversing itself on reconsideration, with its then primary focus being on maintaining its docket and sanctioning counsel with "a notice to the bar," so cloud its judgment that it caused it not to give the full and adequate attention to the merits of the main, substantive issue on appeal, which this "pioneering" invention deserved?

- "28 USC 1927" Sanction Related Questions -

1. Did the appeals court satisfy the constitutional "due process" requirement[3] in its *sua sponte* sanctioning of counsel under 28 U.S.C. 1927, as interpreted by this Court in Roadway Express[4], when no prior hearing or other opportunity to address the "fact" issues upon which the sanctions were awarded, was ever given to counsel prior to its decision?

2. Did the appeals court in sanctioning counsel apply a proper standard of conduct under 28 U.S.C. 1927 in its ignoring the requirement of some element of "bad faith" or some like egregious act(s), as

---

[3]"No person shall...be deprived of life, liberty, or property, without due process of law...." (U.S. Constitution, Amend. V.)

[4]Roadway Express, Inc. v. Piper, 447 U.S. 762, 752 (1980); see also Societe Internationale v. Rogers, 357 U.S. 197, 208-212 (1958), which reversed the dismissal of an action for failure to comply with a pretrial discover order for lack of due process and which likewise did not involve any willful misconduct or bad faith.

implied by this Court and required in most (if not all) of the other circuits, in such matters?

3. Where a counsel is representing an indigent but worthy "pioneering" inventor on effectively a "pro bono" basis -- while he himself also was suffering substantial financial duress and great logistical problems but had no one else to turn to -- was counsel's admitted "burdening the appellate court with 'rag tag' and 'rough edge' performances with hurried work products" sufficient under the circumstances of this case to justify the extraordinary remedy of personal sanctions under 28 U.S.C. 1927?

4. Was it appropriate for the appeals court to sanction counsel for certain specified acts, in which a major part of the criticized acts was a long string of extensions of time, when those extensions were necessitated in the first instance by a delay of a number of months in the court

reporter's preparing and filing the trial transcript and in the second instance by the clerk's office of the district court losing the trial record, including the exhibits the parties wished to refer to in the appeal; while in contrast sanctioned counsel needed less extended time for his direct needs than Zeringue's counsel did in the filing of their respective briefs? Was it an abuse of discretion, as well as a deprivation of due process, for the appeal court not to allow counsel to bring to the court's attention, *inter alia*, these facts before it *sua sponte* sanctioned counsel without a hearing?

5. Was the appeals court clearly erroneous when it "gratuitously" held *sua sponte*, without the benefit of a hearing or other adversative proceeding, that counsel had made a false[5] representation to the

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[5]Counsel strenuously contests that there was any misrepresentation, as brought out below.

court? Did it compound its error when it used that as a further ground justifying its sanctions under the statute, which supposed misrepresentation was not at all material to the case and was not a cause of any excess fee or increased cost to the opposing parties?

6. Does 28 U.S.C. 1927 allow the awarding of sanctions far in excess of that which could be attributable to the acts criticized by the appeals court or incurred by the parties?

7. Has the appeals court below, in zealously attempting to control its docket, gone too far, establishing a precedent that will have a "chilling" effect on the actions of future legal counsel in general, particularly in "pro bono" cases, especially where the available, otherwise willing counsel themselves are not wealthy?

PARTIES TO THE PROCEEDINGS

The caption of the case above contains the names of all the parties. Counsel is not aware of any particular related companies to the one active corporate party, namely, defendant Thomson International, Inc. It is believed that Labadieville Machinery Co., Inc. is no longer in business. Zeringue's Farm Equipment Service is a partnership of Henry Zeringue and John Clet Landry.

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APPENDIX LISTING:[6]

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B - CAFC's Order of January 5, 1989 re Sanctions (as reported in the United States Patents Quarterly)

C - CAFC's Judgment of January 5, 1989

D - CAFC Clerk's Order of February 7, 1989 Denying Petition for Rehearing

E - CAFC Clerk's Order of February 17, 1989 Declining Suggestion for Re-Hearing *en banc*

F - (1) CAFC's Order of September 6, 1988 Dismissing Appeal for Failure to Prosecute (Not Timely Filing the Appendix), Finding Appeal Frivolous & Awarding Reasonable Attorneys' Fees Against Mr. Julien & His Counsel

F - (2) CAFC's Order of December 7, 1988 Reversing Itself on Reconsideration & Finding That the Appeal Was Not After All "Frivolous".

G - Trial Court's Opinion of November 17, 1986

H - Julien Patent-In-Suit 3,286,858

I - Julien Trial Exhibits PX 10(A) & 10(B)

J - Later Usie Patent 3,865,261 (Joint Trial Exhibit)

K - Julien's Counsel's Affidavit of October 3, 1988

L - Julien's Counsel's Young Associate's Affidavit of September 26, 1988

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[6]Petitioner is submitting Appen. C-P in a separately bound "Supplemental Appendix."

M - Brochure Entitled "A Creative Idea...A Reality - A Challenge to Youth (1964) [Julien Trial Exhibit & Exhibit Filed with the U.S. Patent Office in Julien Patent Application]

N - Zeringue Defendants' 3 Page Motion to Dismiss Appeal For Failure to Timely File Appendix (09/01/88)

O - Zeringue Defendants' Application for Attorneys' Fees (09/88)

P - Thomson's Application for Attorneys' Fees (09/15/88)

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1989

No.

LEONARD J. JULIEN,
Petitioner,

versus

HENRY ZERINGUE, ZERINGUE'S FARM EQUIPMENT SERVICE and JOHN CLET LANDRY; and

THOMSON INTERNATIONAL, INC., LABADIEVILLE MACHINERY CO., INC., and ROBERT BOUDREAUX,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Leonard J. Julien, Sr., plaintiff-patentee below, petitions for the issuance of a writ of certiorari to review the opinion, order and judgment of the Court of Appeals for the Federal Circuit of January 5, 1989 in the consolidated cases of Leonard Julien

v. Henry Zeringue, Zeringue's Farm Equipment Service and John Clet Landry, and Leonard Julien v. Thomson International, Inc., Labadieville Machinery Co., Inc., and Robert Boudreaux (CAFC appeal Nos. 87-1115, -1139).

OPINION BELOW

The opinion of the Court of Appeals for the Federal Circuit of January 5, 1989, concerning the patent issues, is reported at 864 F.2d 1569, and its accompanying order, imposing sanctions personally against counsel, is reported at 864 F.2d 1572. Copies of them, *inter alia*,[7] are provided in the Appendix (Appen. A & B).

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[7]A copy of the accompanying Judgment, issued as a mandate on March 29, 1989 (Appen. C), and the subsequent order of February 7, 1989 denying a petition for rehearing and a subsequent order of February 17, 1989 declining a suggestion for rehearing in banc (Appen. D & E) are contained in a separately bound "Supplemental Appendix." It is believed that neither the Judgment nor any of these later orders are officially published.

JURISDICTION

The decision of the court of appeals was issued on January 5, 1989. A petition for rehearing was timely filed and denied by the court of appeals on February 7, 1989 (Appen. D).

The jurisdiction of this Court rests on 28 U.S.C. 1254 and 28 U.S.C. 2101(c) to review the judgment by writ of certiorari to the United States Court of Appeals for the Federal Circuit.

STATUTE INVOLVED

In an order accompanying its opinion the appeals court *sua sponte*[6] sanctioned counsel under 28 U.S.C. 1927, which provides:

> "**Counsel's liability for excessive costs**
>
> Any attorney or other person admitted to conduct cases in any court of the United States or any Territory thereof who so multiplies the proceedings in any case unreasonably and vexatiously may be required by the court to satisfy personally the excess costs,

---

[6]Defendants had moved for attorneys' fees and costs, when the Appendix was filed late, and the Zeringue defendants had urged in their brief that the appeal was "frivolous" and that an award should be made under Fed.R.App.P. 38. However, no one had requested any award for any supposed delay, and no one asserted that the requests for extensions of time were anything but justified, and indeed **none were opposed.** No one requested a sanction under 28 U.S.C. 1927, and no one asserted that counsel personally had made a misrepresentation to the court. The two premature findings of extensive delay and supposed misrepresentation were, it is believed, key to the court's ultimate award. Indeed, it is believed that the court below would not have made such determinations, if it had allowed the required due process to counsel before it *sua sponte* rendered its order in a "notice to the bar."

expenses, and attorneys' fees reasonably incurred because of such conduct." (As amended September 12, 1980, Pub.L. 96-349, § 3, 94 Stat. 1156.)

STATEMENT of the CASE

- The Trial Court Proceedings -

The suit below was for asserted infringement of U.S. Patent 3,286,858 obtained by Mr. Julien on a sugar cane planter that "revolutionized the industry at the time of its inception" (FF. 27). Suit was filed in the Eastern District of Louisiana, which had jurisdiction over the patent suit under 28 U.S.C. 1338 & 2201.

Over two and a half years after trial the district court finally rendered its decision[9] and held[10] the patent to be valid and found the invention to be a "pioneering"

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[9]Appen. G.

[10]Civil Action Nos. 82-0673 & 83-2267 (Collins, J.; Nov. 17, 1986) [1986 WL 13150; Appen. G].

revolutionary one," but then found that the

"This finding of a "pioneering" invention was well grounded. As the trial court found:

"22. Prior to 1964, the Louisiana sugar cane industry had successfully mechanized all of the agricultural aspects of the sugar cane industry, including the ground preparation, loading, transporting, ground finishing, harvesting, and unloading of the cane. The only area which had not been successfully mechanized was the planting operation, which required a relatively careful metering of cut whole cane stalks, approximately six to eight feet and somewhat crooked along its length, down a line in over-lapped fashion in a furrow in the ground.

"23. Until 1964, the planting of cane had to be done totally by hand or with the assistance of a planter's aid wagon which required hand-labor to move and position the cane from the wagon into the furrow.

"24. For many years prior to 1963, well-funded researchers and workers in the Louisiana sugar cane field attempted to fulfill the long-felt need in the sugar cane industry for a fully mechanized sugar cane planter, but to no avail.

"25. These prior, unsuccessful attempts included substantial efforts by the U.S. Department of Agriculture in cooperation with the Sugar Cane League in the mid-50's; LSU's School of Agriculture in the late 1950's and early 1960's; and the engineering divisions of J&L Engineering, Thomson International Co. (*nee* Thomson Machinery) and the Cane Machinery and Equipment Co. (CAMECO), which were the largest cane machinery manufacturing companies in the

(continued...)

patent was **not** infringed under the doctrine of equivalence[12] by the accused machines of defendants.

The detailed findings of fact, which discussed the structure and operation of the machines, were adopted from pre-trial proposed findings submitted **by Mr. Julien**, and

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[11](...continued)
industry and all established innovators.

"26. Plaintiff, a farmer in Modeste, Louisiana, invented, developed, built, demonstrated and successfully operated the first fully mechanized, successful, practical machine for planting whole Louisiana sugar cane with its crooked length in 1961 through 1964.

"27. His pioneering invention was immediately recognized as the first successful solution to the industry's long standing need for such a machine to replace the inefficient, expensive and generally unavailable hand-labor theretofore required for cane planting. The Julien planter was seen as the final link that was needed for the full mechanization of planting and harvesting of Louisiana sugar cane. Exhibits submitted by Plaintiff convince this Court that the device had indeed revolutionized the industry at the time of its inception." (Appen. G, pp. 5-7.)

[12]This was the sole ground Mr. Julien through counsel maintained that the patent was infringed.

they went into great detail in showing the common principles of means, operation, function and result of the machines and the patented invention[13] (TC's FF 26-29 & 32-42; Appen. G, pp. 6-8 & 9-12). In contrast, the trial court in its subsequent section dealing with the doctrine of equivalence, as a general rule, merely cataloged a series of machinery elements or claim words, which it in turn copied from **defendants'** pre-trial submissions, which concluded that none of the alleged infringing devices included such-and-such "or the equivalent thereof" (TC's FF 48-82; Appen. G, pp. 13-18). In stating these conclusions the trial court gave no separate analysis of means, function or result[14] contrary to the detailed supportive findings the trial court had already

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[13]Which are the analysis factors to be used under the doctrine of equivalence as established by this Court in Graver.

[14]As effectively required by this Court in Graver.

made and had adopted from **plaintiff**'s submissions.

Finding 56 is exemplary and key to one of the issues at hand:

> "56. None of the alleged infringing devices include **grab**[15] means, or the equivalent thereof."

This is in stark contrast to the trial court's preceding, detailed discussions and fact findings on the structure and operation of defendants "grabs" [a term it particularly used to refer to defendants' cane engaging means at least eight times (FF 33, 34, 37, 38 (twice), 40, 41 & 42)]. For example, in Findings 37 & 33:

> "37. (Defendant) Zeringue, after making the 'V' shaped finger grabs for the Julien planters for one of Mr. Julien's licensees, made cane planters with the so-called 'rake' or 'V' shaped wedge **grabs** substantially identical to those of Gomez & Andre."
>
> "33. In the Julien planter, the variable width grabs were made

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[15]All emphasis in this and the other findings have been added.

> of opposed, pivoted fingers which were biased toward each other 'with give' through a non-destructive spring bias. The opposed pivoted fingers formed a larger 'V' shape when opened and a smaller 'V' shape when closed. In the Gomez & Andre [Zeringue] planter,[16] the **grabs** were made from the so-called 'rake' structure, which formed a 'V' shape. It had a variable width wedge structure into which the cane was engaged and wedged."

With that background and having called defendants' cane engaging means "grabs" at least eight times, to then find that defendants had no "grab means or its equivalent" was clear error on a most material point.

The trial court also found that the Julien invention was a "pioneering," **revolu-**

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[16]Andre & Gomez were the subject of a separate, prior suit in the Middle District of Louisiana, in which the substantially identical "grabs" were held to be the equivalent of the Julien grabs within the context of the pioneering Julien invention, and affirmed by the 5th Circuit Court of Appeals (TC's FF 34; Julien v. Gomez & Andre Tractor Repairs, Inc., 438 F. Supp. 763, 196 USPQ 224 (DC M.LA. 1977), *aff'd.*, 607 F.2d 1004 (5th Cir. 1979); see also 213 USPQ 224 (accounting phase with damage award).

tionary one (FF 26, 27 & 29) and, indeed, in one of the relatively few statements in its 24 page opinion that the trial court did not adopt from the parties' submissions or copy from the single previous patent case it had handled,[17] found that:

> "Exhibits submitted by plaintiff convince this Court that [plaintiff's] device had indeed revolutionized the industry at the time of its inception." (FF 29.)

The trial court further held that "(Mr. Julien's) patent is...deserving of **broad** and

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[17]As stated by the Zeringue defendants in their analysis of the opinion, "In fact, with the exception of the introductory paragraph, FF 30, 31, 45, 85, 86, parts of 27-29, and CL 21-27, the trial court's opinion was constructed by cutting and pasting from the pre-trial submissions of the parties and the trial court's previous opinion in Kori Corp. v. Wilco Marsh Buggies and Draglines, Inc., No. 79-3636, slip op. (E.D.La., Dec. 11, 1981), aff'd 708 F.2d 151 (5th Cir. 1983). (App. 2091-2111) The trial court's FF 30-31 and CL 1-20, 23 were taken essentially unchanged from FF 66-67 and CL 1-20, 23 of Kori with only minor modifications of names, patent numbers and claims." (Brief For Defendants/Cross-Appellants; p. 2.)

primary treatment" (FF 29) and stated the applicable law as follows:

> "(CL) 19. One form of infringement occurs when an accused device incorporates a teaching literally read. An infringement also occurs when a device appropriates a prior invention by incorporating its innovative concept and, albeit with some modifications and change, performs substantially the same function in substantially the same way to achieve substantially the same result. The 'doctrine of equivalents' shields the inventor from such abuse. (Citing authority.)"
>
> "(CL) 20. The determination of equivalency involves an examination of the scope of prior art, the essence or 'heart' of the invention disclosed and the step forward the invention offers. (Citing the same authority.)" (Appen. G, p. 23.)

As noted above, all of the specific detailed discussions and findings concerning the operation, structure and result of the machines and the invention favored a finding of equivalency under these conclusions of law, as well as under this Court's basic decision on the doctrine of equivalence in Graver (1950) and the CAFC's consistent line

of authority interpreting Graver up to around that time (1986).[18]

The mere catalog listing of "such-and--such" and no equivalent, which constitutes a technical conclusion generally without any indicated underpinnings, would not and should not, in counsel's view, stand up on appeal against the contrary, very detailed findings of fact showing the equivalent

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[18]Note, for example, Martin v. Barber, 755 F.2d 1564, 225 USPQ 233 (Fed.Cir. 1985); D.M.I., Inc. v. Deere & Co., 755 F.2d 1570, 225 USPQ 236 (Fed.Cir. 1985); and, particularly, Hughes Aircraft Co., v. United States, 717 F.2d 1351, 219 USPQ 473 (Fed.Cir. 1983). For example, the latter stated:

> "The failure to apply the doctrine of equivalents to the claimed invention as a whole, and the accompanying demand for 'obvious and [or] exact" equivalents of two elements the presence of which would have effectively produced literal infringement, was error." (Emphasis added; 219 PQ at 482.)

However, as brought out below, the CAFC apparently turned its back on its past precedents and begin taking an approach that cast some doubt on the validity of these precedents.

operation, means and results, in an appeals court experienced in patent matters.

Accordingly, Mr. Julien brought an appeal to the Court of Appeals for the Federal Circuit based on the non-infringement/no-equivalence issue, while the Zeringue defendants cross-appealed the holding of patent validity.

- The "Pro Bono" Aspects of the Julien Case -

In order to fully understand the events which led up to the "sanctions" under 28 U.S.C. 1927, some knowledge of the "behind the scenes" facts of the Julien side of the case is necessary.[19]

Notwithstanding the fact that he was a "pioneer" inventor, deserving of "broad and primary treatment," the manufacturing of defendants' machines **without** the payment of

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[19]These facts are primarily based on an extensive affidavit (Appen. K) counsel filed in the case, supplemented by an affidavit (Appen. L) of his young associate, who was the staff person assigned to prepare the Appendix for the appeal to the CAFC.

patent licensing fees, caused significant financial damage to Mr. Julien,[20] and with the downturn in Louisiana's agricultural fortunes, Mr. Julien never was able to pay for all of the out-of-pocket expenses of the litigation, much less pay **anything** toward the reduced legal fees counsel had agreed to. As a result, counsel, who in the last several years has become primarily a "one man" operation, had suffered through the trial and into the appeal a loss in billing values and costs in excess of $100,000.00.

This was occurring at a time when the downturn in Louisiana's "oil and gas" economy also caused a number of counsel's previously good paying clients to go into

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[20]Indeed, as will be shown at any accounting for patent damages, Mr. Julien and his sons with the assistance of the U.S. Small Business Administration built a manufacturing facility on their farm to build the planters themselves, as Zeringue and others, who had worked under license, turned to building the infringing machines. But the infringements did them in before they could recover their manufacturing momentum.

bankruptcy and others to become "slow pay," if not "no pay" clients. All this likewise caused counsel great financial hardship,[21] depriving him of the opportunity of being able to hire others to work on the Julien case on what had become effectively a "pro bono" case.

Additionally, a death in counsel's in-laws in Connecticut made it desirable and his financial challenges made it incumbent for he and his own immediate family to spend most of their time there. While there, counsel works on a near full time basis as a consultant to the Patent Department of a large New England conglomerate.

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[21]Counsel has not been oblivious to these results, and indeed over the past several years has moved his family to Connecticut to live in his mother-in-law's house after the death of his father-in-law; transferred his children from private schools into public schools; disposed of what once were three cars, leaving a banged-up station wagon with now over 100,000 miles, etc.

Notwithstanding these difficulties, because he had always believed in the merits of Mr. Julien's case and the great moral worthiness of Mr. Julien as an individual,[22] and because counsel knew of no one else[23] who would handle what had effectively become a very expensive "pro bono" case costing in excess of $100,000.00 in value, counsel continued to try his best to help Mr. Julien.[24]

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[22]One can get a good feel for the kind of person Mr. Julien is by reviewing the brochure entitled "A Creative Idea...A Reality - A Challenge to Youth (1964)" filed with the U.S. Patent Office in the Julien Patent Application and entered as a trial exhibit (Appen. M).

[23]Counsel's young associate in his New Orleans' office, who had law clerked for him for several years, did agree to help out in the logistical end of things on a "pro bono" basis, and he in particular was assigned the task of preparing the Appendix for the appeal. Counsel's other associates had declared that they would no longer handle any more "freebie" work.

[24]This basically now entails counsel generating his work in the back room of his mother-in-law's house, reviewing documents

(continued...)

However, counsel through his young associate assistant, who had agreed to help out on a "pro bono" basis, ran into some difficulties in preparing the Appendix for the appeal. This was due to a number of factors, including - the district court staff losing the trial record and exhibits; the young, new-to-the-bar associate not theretofore being in involved in the Julien case and not being familiar with the exhibits; counsel's records in the Julien case having become disorganized as a result of two or three moves in the office and the file storage areas after the trial; and the absence of counsel from his New Orleans office for approximately ninety percent of this time period.

The parties filed their main briefs and counsel initially did intend to file the

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[24](...continued)
and "banging away," as now, on his home "office" computer.

optional reply brief, allowed **but not required** under Fed. R. App. P. 28(5)(c).[25]

However, another "pro bono" case[26] before the CAFC intervened. In this additional case, the inventor's unsuccessful trial counsel declined to continue to represent the inventor for the appeal, after the inventor had run out of funds, notwithstanding his having spent hundreds of thousands of dollars in the trial effort. Because this counsel had known the inventor for a number of years, was at least generally familiar with the case, believed the case to have merit with tremendous potential for public good if successful, and believed

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[25]"The appellant **may** file a brief in reply to the brief of the appellee...." (Emphasis added.)

[26]Newman v. Quigg (Commissioner, USPTO), CAFC appeal No. 88-1312; for background information see In re Newman, 763 F.2d 407, 226 USPQ 97 (Fed.Cir. 1985); In re Newman, 782 F.2d 971 (Fed.Cir. 1986); and Newman v. Quigg, F.2d , 5 USPQ2d 1880 (D.C.D.C. 1988).

that, like Mr. Julien, the inventor would have no reasonable chance of success if left to pursue his appeal alone on a "*pro se*" basis, counsel agreed to and did help him write his briefs and assisted him when he made his oral argument.

However, part of this "Newman" effort took the only time counsel had available to prepare the optional reply brief in this case, and counsel ultimately decided to rely on his main brief and the then upcoming oral argument. But, counsel did fail to realize that the lack of filing the optional reply brief effectively accelerated the time for filing the extensive, many hundred page Appendix, the deadline for which is based on the filing date of the last filed reply brief,[27] which with the reply brief being optional can vary, rather than on a specific, independent deadline.

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[27]Fed. Cir. R. 30(4).

When the CAFC clerk's office by letter brought to counsel's attention that the Appendix was then past due and needed to be promptly filed, he telephoned his young associate in New Orleans to finish it up, get it out and on file as soon as possible, and the several hundred page Appendix was filed less than three weeks after the notice was received. However, the young associate on counsel's behalf failed to include a motion for the court to accept the filing of the late Appendix, but then he immediately sent out one when this discrepancy was brought to his attention by the clerk's office by telephone.

However, between the two or three work days between the receipt of the Appendix in the clerk's office and the filing of the motion for late acceptance, Zeringue's counsel filed a motion for dismissal due to the late filing of the Appendix. Within a work day of the filing of the Zeringue motion and

without giving the Julien side a chance to oppose the motion and bring out the relevant facts, the appeals court granted the motion. In granting the motion, the court dismissed the appeal just short of a week before the time set for oral argument, and further opined that the appeal was in its view "frivolous"[28] and awarded reasonable, then unspecified attorneys fees to all of the defendant/appellees to be paid jointly by Mr. Julien, the "pioneer" inventor, and his counsel (Appen. F-1). Counsels for appellees then filed documentation requesting awards totaling approximately $65,000.00 (see Appen. O & P), most of which was being requested by the Zeringue defendants.

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[28]The appeals court has never explained on what ground or through what rationale it found the appeal "frivolous", although it indicated it would give its reasons in a future communication (Appen. F). However, ultimately the appeals court was persuaded by Mr. Julien's petition for reconsideration that indeed the appeal was not "frivolous" and reversed itself.

Julien then filed an extensive 50+ page petition for reconsideration with extensive supporting documentation,[29] somewhat "shooting in the dark" since the appeals court had not given its reasons for finding the appeal supposedly "frivolous." In the petition he brought out the patent infringement merits of his case, discussed the additional, more recent decisions[30] of the CAFC which were published after most of the legal research had been done on the Julien brief, and explained the circumstances surrounding the late filing of the Appendix. Because they were not then in issue, there was no discussion or consideration given by counsel to the various extensions of time or the

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[29]For which he sought and received short, reasonable extensions of time, totaling 11 days, all of which were unopposed.

[30]Including particularly the Pennwalt decision discussed below and how, even under its divergent holdings, as best they could be understood, the infringement case had merit.

supposed "misrepresentation" to the court discussed below.

On reconsideration (Appen. F-2), the appeals court on December 7th concluded that the appeal was not after all "frivolous" and withdrew its dismissal, indicating that it would go ahead and treat the appeal on the merits, but would do so without oral argument, and denied the Zeringue appellees their requested permission to file a reply brief, which was **un**opposed by Julien.[31]

Then, four weeks later on January 5th the appeals court, perhaps working over the Christmas/New Year's holidays (which consumed some 10 days or so of the 28 days),

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[31]Julien had hoped that, if a further brief was filed by the defendants, the appeals court would also allow oral argument, so that the appeal could finally get the full consideration it deserved.

issued a somewhat perfunctory[32] decision denying the merits of the appeal.

- The Patent Aspects of the Appeals Court's Opinion -

- The Appeals Court Misapplied the Doctrine of Equivalents -

In considering the merits of the appeal and in particular the doctrine of equivalence, the appeals court opined - "If a **claim limitation** or the substantial equivalent is not present, there can be no infringement", relying on its decision in Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 934-35, 4 USPQ2d 1737, 1739-40 (Fed.Cir. 1987) (in banc), *cert. denied*, ___ US ____, 108 S.Ct. 1226 and 1474, 99 L.Ed.2d 426 and 703 (1988) [emphasis added]; as well as one of its earlier cases.

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[32]No consideration was given at all to the well established legal principle that a pioneering inventor like Mr. Julien is entitled to a broad range or scope of equivalence under the doctrine of equivalents; see for example this Court's decisions in Graver and Miller, discussed more fully below.

This apparent "micro" word-by-word "claim limitation" approach for the doctrine of equivalence, not even just an "element-by-element" approach, takes the theory beyond any previous "micro" boundary. In contrast this Court's decision in Graver[33], reviewed more fully below, took an over-all, relatively "macro," contextual or "device" (rather than a "claim limitation") approach.

The Pennwalt decision was an in banc, split decision having totally diverging, very strongly expressed views, even disagreeing in the majority view as to whether the CAFC's previous, oft cited decision in Hughes was being set aside. In view of the CAFC's unique role as the **sole** appellate arbiter in patent matters (subject of course to this Court), this divergence is analogous to a "split in the circuits," which only

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[33]Graver Tank & Manufacturing Co., Inc. v. Linde Air Products, 339 U.S. 605, 607, 85 U.S.P.Q. 328, 330 (1950).

this Court can resolve. Additionally, the majority view in it, like the decision below, is at odds with this Court.

The doctrine of equivalents is best expressed by this Court's teachings in Graver:

> "'To temper unsparing logic and prevent an infringer from stealing the benefit of an invention' (L. Hand in Royal Typewriter Co. v. Remington Rand, 168 F.2d 691, 692, 77 USPQ 517, 518) a patentee may invoke this doctrine to proceed against the producer of a **device** 'if **it** performs substantially the same function in substantially the same way to obtain the same result.' Sanitary Refrigerator Co. v. Winters, 280 US 30, 42 [3 USPQ 40, 44]. The theory on which it is founded is that 'if **two devices** do the same work in substantially the same way, and accomplish substantially the same result, **they** are the same, even though they differ in name, form, or shape.' Machine Co. v. Murphy, 97 U.S. 120, 125." (Emphasis added.)
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> * * * *
>
> "What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum. It does not require complete identity for every purpose and in every respect. In determining equivalents, things

> equal to the same thing may not be equal to each other and, by the same token, things for most purposes different may sometimes be equivalents. Consideration must be given to the purpose for which an ingredient is used in a patent, the equalities it has when combined with the other ingredients, and the function which it is intended to perform."

Graver Tank & Manufacturing Co., Inc. v. Linde Air Products Co., 339 U.S. 605, 609, 85 USPQ 328, 330-331 (1950).

This Court's doctrine had previously been interpreted by this same Court of Appeals for the Federal Circuit as making the "element-by-element" approach (much less its current "claim limitation" approach) erroneous as a matter of law.

As the CAFC had previously stated in Martin v. Barber, 755 F.2d 1564, 225 USPQ 233 (Fed. Cir. 1985), in vacating a summary judgment of non-infringement:

> "To determine whether [the accused device] and the claimed invention are equivalent, the fact finder must decide whether the components of the [accused device], **viewed as a whole**, operate in substantially the same way, and have

> substantially the same function and result, as the claimed invention." (Emphasis added; 225 PQ at 235.)

Similarly, in D.M.I., Inc. v. Deere & Co., 755 F.2d 1570, 225 USPQ 236 (Fed. Cir. 1985), this Court, in reversing another summary judgment of non-infringement, discussed fact issues involved in the application of the doctrine of equivalents, and indicated that the **invention-as-a-whole** approach was appropriate in applying the doctrine, as follow:

> "In applying the doctrine of equivalents, the fact finder must determine the range of equivalents to which the claimed invention is entitled, in light of the prosecution history, the pioneer-non-pioneer status of the invention, and the prior art. It must then be determined whether the **entirety** of the accused device or process is "substantially the same thing, used in substantially the same way, to achieve substantially the same result" as to fall within that range." (Emphasis added; 225 PQ at 239.)

Of like interest and prior clear guidance was the CAFC's earlier decision in Hughes Aircraft Co. v. United States, 717

F.2d 1351, 219 USPQ 473 (Fed. Cir. 1983), wherein a judgment of non-infringement under the equivalents doctrine and the trial court's element-by-element approach was **reversed**, stating:

> "The failure to apply the doctrine of equivalents to the claimed invention **as a whole**, and the accompanying demand for "obvious and [or] exact" equivalents of two elements the presence of which would have effectively produced literal infringement, was error." (Emphasis added; 219 PQ at 482.)

These earlier views of the CAFC were better reasoned and more effectively secured the policy goals expressed in Graver and were correct. The later, relatively "microscopic" views expressed in the case at bar and in Pennwalt were an unfortunate divergence and should be held to be erroneous as a matter of law.[34]

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[34]Indeed such "microscopic" word-by-word approaches, in which each word or claim limitation or even an individual element is considered outside of the overall context of the invention, inexorably leads a court to "not being able to see the forest for the trees."

- A "Pioneering" Invention Is Entitled to a Broad Range and Scope of Equivalents -

Additionally, as here, if the invention is broad or primary in character, the range of equivalents will be correspondingly broad. Miller v. Eagle Manufacturing Co., 151 U.S. 186 (1894).[35] As noted by this Court in Cimiotti Unhairing Co. v. American Fur Ref. Co., 198 U.S. 399, 414 (1905):

> "this record discloses an invention of merit entitled to some range of equivalents...but it is not one of those broad initiative inventions where original thought had been embodied in a practical mechanism, which the courts have been zealous to protect."

Clearly the Julien "pioneering" invention, which "revolutionized the industry at the time of its inception," falls into the latter category, which "the courts [should be] zealous to protect."

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[35]Note also Hildreth v. Mastoras, 257 U.S. 27 (1921); Sessions v. Romadak, 145 U.S. 29 (1892); Morley Sewing Mach. Co. v. Lancaster, 129 U.S. 263 (1889).

Since Miller it has been consistently established by this Court and the other circuit courts of appeal prior to the creation of the CAFC and indeed thereafter by the CAFC that a "pioneer" patent disclosing a function never before accomplished is entitled to broader protection in the form of a broader scope of equivalence with some liberality than one that makes minor improvements on known technology.[36]

The appeals court, with its attention apparently still focused primarily on its docket considerations and in its quick, perfunctory consideration of the patent merits of the case, totally ignored the issue in its January 5th opinion (Appen. A); while

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[36] Note, for example, Continental Oil Co. v. Cole, 434 F.2d 188, 191 (5th Cir. 1981); see also, Hughes Aircraft Co. v. United States, 717 F.2d 1351, 219 USPQ 473, 481 (Fed.Cir. 1983); Weidman Metal Masters Co. v. Glass Master Corp., 623 F.2d 1024, 207 USPQ 101, 103 (5th Cir. 1980); and Vulcan, Inc. v. Fordees Corp., 658 F.2d 1106, 211 USPQ 852 (6th Cir. 1981).

the trial court acknowledged the principle and then failed to apply it. Thus, the pioneering inventor, Mr. Julien, still today after 7+ years of exhausting litigation against these defendants, has yet to receive due and proper judicial consideration on the merits of his case under the sole issue he has raised from the beginning, namely, the infringement of his patent rights under this Court's established principle of the doctrine of equivalence.

As a final note with respect to the patent issues as treated by the appeals court,[37] the CAFC, in support of its finding of non-equivalency based on the "claim limitation" approach, on its own and without any reference to any authority, in clear error, stated that "the accused planters used 'V' or 'W' rakes that engage and transport the

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[37]And a further indication of its "rush to judgment."

cane by stabbing it and raking it down into the trough" (emphasis added).[38]

However, the trial court never found that any such action took place in the accused planters. In fact, the trial court found just the opposite, specifically finding that defendants':

> "grabs were made from the so-called 'rake' structure, which formed a 'V' shape. It has a variable width wedge structure into which the cane was engaged and wedged." (TC's FF 33; emphasis added.)[39]

The trial court consistently termed these elements in defendants' machines as "grabs"

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[38]The appeals court fell into this error by apparently copying from assertions made in the accused defendants' appeal brief, rather than basing it on what the trial court found.

[39]Although this specific finding was directed to a "Gomez & Andre" planter, which was held to be an infringement under the doctrine of equivalence in an earlier case [Julien v. Gomez & Andre Tractor Repairs, Inc., 438 F. Supp. 763 (M.D. La. 1977, aff'd, 607 F.2d 1004 (5th Cir. 1979)], the trial court further found that defendants' "so-called 'rake' or 'V' shaped grabs (were) substantially identical to those of Gomez & Andre" (TC's FF 37).

(TC's FF 33, 34, 37, 38, 40, 41 & 42), typically as "'V' shaped wedge grabs" and in essence ridiculed defendants' position by terming them "**so-called** rakes" (FF 33, 34, 37 & 38) or what were "referred to by defendants as 'rakes'" (FF 32) and consistently putting the word "rake" in quotes (FF 33, 34, 35, 37, 38 & 40).

This analogous, equivalent, non-raking,[40] grabbing action occurring in defen-

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[40]Of course, if defendants' had been interested in a raking action, the "tines" of the so-called "rake" would have been directed against the cane stalks, rather than being positioned parallel to them, as in defendants' machines. The latter results in the cane being wedged into them in a grabbing action rather than being raked.

This action was confirmed in what was originally one of defendants' trial exhibits, namely a patent to a man named Usie, who was apparently the first person to substitute the so-called rake for the pivoting Julien fingers in the patented Julien planter (U.S. Patent 3,825,261; PX 17; Appendix J). As stated in the Usie patent, the planter used a "rake plate...having V-shaped notches for engaging opposite sides of a seed cane stalk for engaging same and moving the stalk along its axis for planting" (Abstract) and "V-notches 41, 42 and 43

(continued...)

dants' machines is succinctly illustrated in plaintiff's comparative trial exhibit 10(A) (Appen. I), with the pivoted Julien "V" finger grabs shown on the left and defendants' "V" shaped wedge grabs (so-called "rakes") shown on the right.

Had the CAFC properly focused on the merits of the case, rather then improperly professionally destroying counsel to send "a notice to the bar" for its docket maintenance purposes, and objectively applied the doctrine of equivalence within the context of the invention as a whole under Graver and further applied the liberality of the broad scope a "pioneering" inventor deserves under Graver and Miller, it would have and should have concluded that the wedging grab action

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[40](...continued)
define wedges into which are received cane stalks 44. The plate 34 engages the cane stalk immediately behind the eye 45 to slide the stalks 44 rearwardly of the cane cart 14 as shown in Figure 1...." (Col. 2, lines 21-26). This is not a raking or stabbing action.

of the cane in defendants' so-called "rake" plates, which effectively present a variable width "V" shape to the cane to grab it at only one point along the cane's length to pull it off the back of the cane wagon is equivalent to the pivoting, spring biased fingers, which open and close to present a variable width "V" to grasp the cane at only one point along it length to pull it off the cane wagon, as shown in the exemplary embodiment of the Julien patent.

- The Sanction Aspects of the Appeals Court's Order -

- The Appeals Court Failed to Provide Due Process -

Concurrently with its patent opinion the CAFC ordered counsel to personally pay $13,437.00 to the defendants, specifically imposing the sanctions under 28 U.S.C. 1927[4]

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[4] **Counsel's liability for excessive costs**

Any attorney or other person admitted to conduct cases in any court of the United States or any Territory (continued...)

and also having the expressed purpose of sending "a notice to the bar".[42] It specified the grounds for its imposition, but **never** afforded counsel a hearing on the matter or other opportunity to address the issues **before** it rendered its order, depriving counsel of the requisite due process; Roadway Express, Inc. v. Piper et al, 447 U.S. 752, 767 (1980); Societe Internationale v. Rogers, 357 U.S. 197, 208-212 (1958); U.S. Constitution, Amend. V. The appeals court sought to excuse the lack of a hearing

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[41](...continued)
thereof who so multiplies the proceedings in any case unreasonably and vexatiously may be required by the court to satisfy personally the excess costs, expenses, and attorneys' fees reasonably incurred because of such conduct."
(As amended September 12, 1980, Pub.L. 96-349, § 3, 94 Stat. 1156.)

[42]"The bar is now on notice, however, that failure to comply with this court's rules, including the requirements for preparing and filing briefs, appendices and other papers, may result in the dismissal of an appeal for failure to prosecute." [Appen. B, p. 3 (PQ p. 1556)].

or a rule to show cause by referring to its earlier, non "frivolous" appeal rulings and now vacated reconsideration proceedings, but the issues there were different and the sanctions were based on "facts" not previously considered.

As a result of not allowing comment before issuing its order, it made several clear errors that were an abuse of discretion. It castigated counsel in quite personal terms for a multitude of many months of extensions in what has now become a permanent, highly public legal record (864 F.2d 1572 *et seq.*), but effectively didn't allow counsel to bring to the court's attention that the many months of extensions primarily were necessitated in the first instance by the court reporter's inability to provide the trial transcript, initially because she couldn't find her transcript notes, and thereafter because the district court itself kept her too busy. In the second instance,

several more months were needed primarily because the district court staff lost the trial record and time was sought to allow it to find the records so counsel through his young associate could complete the Appendix.[43]

In fact, counsel for his own needs needed a lesser time extension (a matter of some days) to complete his main brief than was necessary for the Zeringue defendants. Additionally, none of these extensions were opposed nor caused any "excess costs".

Indeed, unlike other cases, where lawyers are in fact guilty of vexatious conduct trying to "run the other side down" or to generate fees for themselves, it was never to counsel's advantage to protract the litigation or to multiply the proceedings, as he

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[43]They never did find it, and much digging work had to be done to reconstruct the record for the extensive Appendix, requiring the use in some instances of relatively poor copies on which markings and notes appear.

was the attorney without a paying client and was working effectively on a "pro bono" basis. In fact, he was having difficulty trying to keep up with the activities of Zeringue's counsel, who from their own filings had made in excess of $50,000.00 just in the appeal, much less the far greater amounts generated in the many years of litigation at the district court level.

- There Was No Misrepresentation to the Court -

Additionally, the appeals court felt that counsel had made a "misrepresentation" to the court, but such was not the case. The appeals court asserted that counsel made a "false representation" when he told the court that "the Julien case [was] the last piece of significant litigation for which he had any responsibility," because he also had another appeal concurrently proceeding before the same panel, namely the Pan American appeal (Appeal 88-1536). Counsel's state-

ment was made in his extensive affidavit filed in support of the petition for reconsideration in the following context (p. 24, Appen. K):

> "Regardless of the final outcome of the Julien case, which is the last piece of **significant** litigation for which he has any responsibility, he has finished his career in litigation and has no intention of taking on the responsibilities of any further cases, certainly none at the trial level. However, this decision of his has nothing to do with the order of September 6."[4] (Emphasis added.)

It should be recalled that the Julien case has been one entailing extensive trial litigation before a court involving legal expenditure values per side of at least $100,000-$200,000, with an extensive trial at the district court level with many witnesses, including expert witnesses, and concerned a pioneering invention. In contrast, the Pan

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[4] "In order to spend more time with his family and in connection with his move to Connecticut, counsel has stop taking, and indeed has turned down, new patent infringement litigation assignments.

American matter involved an administrative review from the Trademark Division of the U.S. Patent & Trademark Office (USPTO) involving a trademark application. In the context of the Julien case, it was not relatively significant in terms of money, time, complexity, or import.

In referring to "**significant** litigation" counsel had in mind the many relatively heavy duty litigation cases he had been involved in over the years, typically involving one or more patent infringement suit(s) before a district court. As he stated in his affidavit:

> "Over the past 20+ years he has handled or been involved in litigation, primarily patent litigation, in the federal courts, in the states of Louisiana, New York, Mississippi, Illinois, California, the District of Columbia, Texas, Missouri, Alabama and Rhode Island, and has successfully handled appeals through the federal appellate route, including the U.S. Supreme Court [Deepsouth v. Laitram 406 U.S. 518, 173 USPQ 769 (1972)], wherein, with the help of others, a 5-4 favorable decision was obtained. In his litigation

> work he has won most and lost very few of his cases." (pp. 2-3, Appen. K)

Although he has stopped being primarily responsible for such litigation, he has continued to do administrative work before the USPTO in matters involving applications or registration for patent or trademark. In the context of the statement, he generally does not consider appeals in such administrative matters, and in particular did not consider the Pan American administrative appeal, to be "**significant** litigation."

Indeed, remembering that both the Julien and the Pan American cases were concurrently before the same court, it would have been at the very least "*non corpus mentis*" to have made any such false representation.

However, the Pan American case does provide a further example of the extremes this appeals court has taken in its position of "If the judicial process is to function

effectively, we must retain the ability to control our docket and dismiss cases where counsel fail to perform their duties." [Appen. B, p. 3 (PQ p. 1556)]. In Pan Am counsel had requested a first extension of time of six weeks to file the brief; no other extensions of time had been previously requested. Counsel was informed of the granting of a much less extension, approximately a week before the brief was due on the shortened extension.

Despite the shortness of time, with extensive efforts, the legal research was done and the drafting of the brief was completed by the deadline, **and a copy of the brief was filed with the Court by the deadline**. However, counsel, after much searching and calling around by him and his wife to a number of printers and law firms in the surrounding areas, was unable to find a printer in his area of Connecticut who could

do the particular binding required by the appeals court for its briefs.

Accordingly, counsel requested in a timely filed motion, which detailed all of the efforts expended to prepare and file the brief and to find a printer with the relatively rare binding capability, an additional few days time to locate such a printer and allow for the filing of the multiple bound copies of the brief. Six days later counsel supplemented the original brief copy, he had previously timely filed, with the properly bound, multiple copies of the brief. However, the motion was denied, because in the order granting the first extension of time, it was stated that no further extensions would be granted.[45] The appeal was then summarily **dismissed**.

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[45]It is interesting to note that in this case the Zeringue defendants received an additional, unopposed extension of time to file their brief **after** being told in the granting of a previous extension that **no** further extensions would be granted.

It is respectfully submitted that such a harsh, unrelenting policy greatly elevates "form" over "substance", and lacks balance and justice. If a counsel makes substantial, good faith efforts to meet a set deadline, and such efforts were reasonable under the circumstances, but is then kept from being able to fulfil the deadline due to significant, understandable circumstances not under his control or of his making, a further reasonable extension should be granted notwithstanding a previous warning that "no further extensions will be granted."

However, regardless of the merit or lack thereof in the denying of a supplemental six day extension in the Pan Am case, raised by the CAFC in this case to supposedly show a "false representation," the asserted "misrepresentation" was not vexatious to opposing counsel nor did it produce any excess costs.

The court also criticized counsel for failing to file a reply brief.[46] However, as noted above, under the rules such is **optional and discretionary with counsel**, and the lack of doing something discretionary cannot by its very nature be vexatious or cause "excess costs" or attorney fees and indeed could only save costs and fees.

All of these things could have been brought out **prior** to the entry of the

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[46]The appeals court also stated that "Counsel urges that we suspend him from appearing before the court for two years..." [Appen. B, p. 4 (PQ p. 1557)]; however the only things that counsel truly **urged** in the petition for reconsideration was that the appeal was not "frivolous" but instead had good merit, which should be fully considered in the appeal, and that it would be a gross miscarriage of justice to have Mr. Julien (or counsel) ordered to pay approximately $65,000.00 to the defendants, who had reaped the "fruits" of his invention.

Counsel, somewhat "tongue in cheek", did suggest that as a last alternative he be suspended for a reasonable period of time, comparing such suggestion to B'r Rabbit's classical plea to the fox and the bear to please not throw him in the briar patch, in essence suggesting that not practicing before that panel of the CAFC would be doing counsel a favor.

order,[47] if counsel had only been accorded the constitutional due process required by the law. As this Court stated in Roadway:

> "Like other sanctions, attorney's fees certainly should not be assessed lightly or without fair notice and an opportunity for a hearing on the record." (447 U.S. at 767).

Additionally, the court failed to make any finding with respect to any "bad faith"[48]

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[47]After the appeal court had issued its order and sent its "notice to the bar," counsel did file a petition for reconsideration. Its "post facto" presentation after the bar notice had been sent was denied without comment in an order signed by the clerk (Appen. D). What, if any, substantive "post facto" consideration the appeals court gave to it is unknown. Regardless, its twice exercised tendency to "rush to judgment" in this case and the unjustifiably harsh terms it used in its order and its unjustifiable actions in both the Pan Am case and this case showed the court had lost all judicial objectivity in the matter.

[48]Counsel does not deny that his performance had not been up to the standards he attempts to pursue and which he would have desired, but such was not due to any disregard of the court or of his opposing parties. He through his New Orleans office and fresh-to-the-bar associate did mess up on the preparation and filing of the Appendix. Additionally, the very difficult financial,

(continued...)

on the part of counsel, presumably because the court was of the opinion that such is not required under the statute. However, this creates a split among the circuits that only this Court can resolve.

- Most, If Not All, Appeals Courts, Except the Panel Below, Require Some Type of "Bad Faith" For Any Sanction Under the Statute -

Most, if not all, courts of appeal,[49] except this panel of the CAFC, have required some "bad faith" finding or other like egregious conduct.

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[48](...continued)
logistical and time problems he had to work under has made a number of his work products hurried, including regrettably the preparation of this petition to this most honorable Court. But he is in fact attempting to do his best.

[49]This Court apparently has not yet fully considered this issue. This Court did state in Roadway that a finding "tantamount to bad faith...would have to precede any sanction under the court's inherent powers" (447 U.S. at 767); see also Justice Blackmun analysis of the Court's holding re §1927 in footnote 1 of his opinion, concurring in part and dissenting in part with the majority opinion (447 U.S. at 768).

2nd Cir. ■ "Imposition of a sanction under Section 1927 requires a "clear showing of bad faith (citing other 2nd Circuit authority)"; Oliveri v. Thompson, 803 F.2d 1265, 1273 (2nd Cir. 1986); see also Apex Oil Co. v. Belcher Co. of New York, Inc., 855 F.2d 1009, 1020 (2nd Cir. 1988).

3rd Cir. ■ "Section 1927 requires a finding of counsel's bad faith as a precondition to the imposition of fees [citing other 3rd Circuit authority]" Gaiardo v. Ethyl Corp., 835 F.2d 479 (3rd Cir. 1987).

6th Cir. ■ *Cf.* Smith v. Detroit Federation of Teachers Local 231, 829 F.2d 1370, 1378-1379 (6th Cir. 1987):

> "More recently, however, we held that the imposition of section 1927 sanctions against counsel 'does not require a finding of recklessness, subjective bad faith, or conscious impropriety; an attorney does not have *carte blanche* to burden the federal courts by pursuing claims that he should know are frivolous.'"

However, in a more recent 6th Circuit decision the court noted:

> "Appeals that are frivolous or are interposed for delay are sanctionable against a party by *this Court* under 28 U.S.C. 1912 and Fed.R.App.P. 38. **More serious** violations of attorney conduct on appeal are sanctionable against the attorney under 28 U.S.C. 1927." (Emphasis added.)

Webster v. Sowders, 846 F.2d 1032, 1040 (6th Cir. 1988).

7th Cir. ■

> "Needler contends that the application of Section 1927 to a case such as this will stultify creativity and dampen the zeal an attorney owes his client. As we emphasized in *Knorr*,[50] courts must be careful not to undercut the orderly development of the law and ethical representation. But the 'bad faith' standard serves this function. Congress believed when it added fees to the list of sanctions under Section 1927 that the enforcement of the traditional bad faith standard would prevent making counsel timorous. See H.R. Conf. Rep. 92-1234, 96th Cong., 2d Sess. 8 (1980)."

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[50]Knorr Brake Corp. v. Harbil, Inc., 738 F.2d 223, 227 (7th Cir. 1984).

In re TCI Ltd., 769 F.2d 441, 447 (7th Cir. 1985); see also Ordower v. Feldman, 826 F.2d 1569 (7th Cir. 1987).

8th Cir. ■ Burull v. 1st National Bank of Minneapolis, 831 F.2d 788 (8th Cir. 1987) (Vexatious or bad faith).

9th Cir. ■ Note Soules v. Kauaians for Nukolii Campaign Committee, 849 F.2d 1176, 1185 (9th Cir. 1988) (bad faith prerequisite).

10th Cir. ■ U.S. Industries, Inc. v. Touche Ross & Co., 854 F.2d 1223 (10th Cir. 1988) (bad faith threshold finding).

Besides the case at hand, the District of Columbia Circuit in Reliance Ins. Co. v. Sweeney Corp., Maryland, 792 F.2d 1137 (D.C.Cir. 1986) takes an approach with a standard other than "bad faith," although not nearly down to the apparent standard of the Julien appeals court. In Reliance the D.C. circuit stated that counsel's "reck-

lessly indifference" to a claim's merits would be sufficient.[51]

Likewise, the Fifth Circuit, in Meyers v M/V Eugenio C, 852 F.2d 806, 814 (5th Cir. 1988), in analyzing the District of Columbia's Circuit's approach in Reliance under Section 1927, stated:

> "Thus, it is not bad faith that establishes frivolity of appeal, but that an unreasonable legal position is advanced without a 'good faith belief that it is justified.'"

However, it is noted that even under the latter, perhaps[52] more diluted approa-

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[51] "While the language of Section 1927 primarily suggests deliberate misbehavior, subjective bad faith is not necessary; attorneys have been held accountable for decisions that reflect a reckless indifference to the merits of a claim [citing the 7th Circuit's In re TCI, Ltd., *supra*]. We adopt these standards in the case at bar." (Emphasis added; 792 F.2d at 1138.)

[52] It would seem that, assuming a counsel is thinking about what he is doing, a lack of good faith belief is tantamount to being in bad faith; *cf.* Meyers.

ches, Julien's counsel here has done nothing justifying any sanction under the statute.

The "messing" up on the preparation and filing of an Appendix and failing to realize that its indirect deadline had passed, while counsel was relying on a young associate to do what basically was a clerical task, and the need to obtain a number of unopposed few days extensions of time for his needs, while counsel was himself operating in good faith under very difficult circumstances, does **not** justify sanctions under §1927[53], nor indeed

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[53]Likewise, the award of $12,087.00 to the Zeringue defendants for their filing of a three (3) page motion (Appen. N) to dismiss for the late filing of the Appendix is clearly excessive and not at all representative of the "excess costs, expenses, and attorneys' fees reasonably incurred because of such conduct" (28 USC 1927) nor was the $1,350.00 awarded to Thomson actually "incurred."

the inappropriate destruction of counsel's professional standing and career.[54]

Counsel candidly admitted that circumstances beyond his control caused the Julien side to sometime burden the appeals court "with 'ragtag' and 'rough edge' performances with hurried work products", and he sincerely apologized to the appeals court for it. However, when one remembers:

○ that the trial court took over 2 ½ years after the trial to render a decision, which then basically was a cut-and--paste job from the parties' pretrial submissions and his single previous patent case;

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[54]After many years of litigation work and accomplishment, with a number of them as an "av" rated patent attorney, counsel had previously served as an expert witness, and indeed had been requested to serve as one in a patent trial a few months ago, which counsel had to decline. The holding by an eminent patent court, such as the CAFC, although "half-baked" as here, that counsel had misrepresented something to the court, will no doubt make things professionally impractical, if not impossible, for any such service or litigation work in the future.

- that the trial court acknowledged that a pioneering inventor like Mr. Julien was deserving of broad and primary treatment under the doctrine of equivalence but then failed to apply the principle to the facts at hand;

- that the appeals court within one (1) work day of receiving a motion to dismiss the appeal for the late filing of the appendix, dismissed the appeal without allowing the filing of any opposition and then *sua sponte* held the appeal to be "frivolous" without explanation and awarded attorneys' fees and double costs against Mr. Julien and counsel, potentially totalling over $65,000.00;

- that the appeals court then reversed itself on reconsideration holding that indeed the case was not frivolous and that it would treat the case on its merits, but would not allow any reply brief by the Zeringue defendants or any oral arguments;

and then approximately 15 working days later issued a perfunctory opinion on the patent issues, totally failing to either recognize or apply the broad and liberal treatment due a pioneering inventor under the doctrine of equivalence, and adopting as "fact" an argument urged by the Zeringue defendants as to the "raking" and "stabbing" operation of defendants' "V" shaped wedge grabs, which was directly contrary to the detailed findings of the trial court;

○ that the appeals court then sanctioned counsel without the due process of prior notice or a hearing and issued such a strongly worded order so personally castigating counsel that his professional standing and career have been neigh on to destroyed; and

○ that counsel was blamed and sanctioned for the long time delays due to the court reporter's inability to prepare the trial transcript and due to the district

court's losing the trial record and exhibits, which not only delayed but greatly complicated the preparation of the Appendix;

it would appear that an even greater apology is due at least Mr. Julien, if not all of the parties,[55] from the judicial system. However, of course, counsel is not as concerned with Mr. Julien receiving an apology, as he is with Mr. Julien finally getting the full and complete consideration due his pioneering inventive efforts under this Court's judicially defined doctrine of equivalence.

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[55]It is at least ironic that the "excess costs and attorneys' fees" caused the parties due to the appeals court's "rushes to judgment" and its "off and on again" handling of the case is truly measurable in the many thousands of dollars, while those due to the justly criticized late filing of the Appendix by counsel's young associate is measurable in a few hundred dollars (*cf.* Zeringue's 3 page motion to dismiss for late filing of appendix; Appen. N).

Certainly counsel would have preferred that Mr. Julien had been, not only a pioneering inventor, but also a wealthy, established businessman who had the resources to do battle the properly financed way, so that help could have been hired or the case could have been referred to someone else to handle. However, in fact he is a poor (in terms of money), black Louisiana farmer that has had to depend solely on this financially strapped lawyer to do battle for him, after his former associates,[56] the defendants, "stole" the fruits of his invention.

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[56]Defendant, Zeringue's Farm Equipment "made finger type grabs for one of Mr. Julien's licensees" (FF 35; Appen. G, p. 10); defendants "Labadieville Machinery/Robert Boudreaux [was a] licensed manufacturer of the Julien planter" (FF 38; Appen. G, p. 10); "Robert Boudreaux, at Labadieville Machinery, [was] Mr. Julien's primary licensee in the early 1970's through 1975. In their final year of active manufacturing operation, Boudreaux/Labadieville Machinery then sold the parts for approximately seven slat-chain-type planters and thereby provided customers for defendant Thomson during 1977." (FF 41; Appen. G, p. 11.)

It is respectfully believed that this good Court would have a true understanding and feeling of the "real world" aspects of this case, if it would take the trouble to review counsel's affidavit of October 3, 1988 and the brochure concerning the invention, the inventor and his family.[57]

Counsel's efforts, albeit "ragtag, rough edged and hurried", in legitimately trying finally to get a truly deserving client his real day in court, is not deserving of personal sanctions nor professional destruction.

Counsel's logistical problems were many, and counsel's actions have always been founded on the sincere belief that Mr. Julien's case had good merit and should win under this Court's judicially defined doc-

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[57] accepted as a trial exhibit and filed with the U.S. Patent & Trademark Office in the file of the patent-in-suit (Appen. K & M of the Supplemental Appendix, respectively).

trine of equivalence, when applied in the context of a pioneering invention.

Counsel has given his $100,000.00 plus of "blood" doing his best during difficult times to see that relative "might does not make right." Perhaps it was extraordinary for counsel to hope that the appeals court below would likewise go beyond the normal call of duty to insure justice to a deserving person, but such was not unreasonable.

In summary counsel earnestly believes and certainly hopes that he can persuade this Court on *cert.* that neither the trial court nor the appeals court below properly followed the precedents of this Court; that the CAFC is in conflict with the other courts of appeal on the sanction issues and within itself on the patent issues, and that the CAFC has abused its discretion and has committed clear error.

REASONS FOR GRANTING THE WRIT

The need to properly protect a "pio-

neering" inventor, who by definition is rare and affords needed revolution to this country's technology, is clear. This is particularly so now, with the lag in our country's innovative and patentable inventions, as compared to past times, as shown by, for example, the increasing foreign dominance of our patent system.[58]

It has now been 39 years since this Court fully considered its judicially defined doctrine of equivalence in Graver, and this Court needs to resolve the effective conflict among the "circuits" presented by the diverging views of the court below.

The need to promote "pro bono" work among the bar is also well known, and has been a special activity of former Chief Justice Burger, as well as of other, current

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[58]Foreign nationals now receive nearly half [approximately forty-eight (48%) percent] of all U.S. patents based on 1988 statistics as compared to only a relatively some percent a few years ago; USPTO's News Release dated March 19, 1989.

members of this Court. To restrict such work only to those counsel who are wealthy to insure that they don't, although in good faith, still become afoul of an appeals court, is not appropriate.

The need of a court to protect its docket is understandable, but not at the sacrifice of sound judicial restraint and the needed dispensing of due justice. The court below has swung the pendulum too far, requiring this Court to exercise its supervisory authority.

The precipitous action of the appeals court panel below in "short-circuiting" the appeal by dismissal, when it had everything in hand to allow the appeal to go forward on its merits, and its quickness to find an appeal "frivolous" without allowing counsel to address the issues, like its sanctioning of counsel without due process, can only serve to provide a chilling effect on our legal system.

The court below has so far departed from the accepted and usual course of judicial proceedings, both with respect to the patent issues as well as to the sanctions, as to clearly call for the exercise of this Court's power of supervision.

Additionally, there effectively are conflicts among the "circuits," on both the patent and the sanction issues, which are purely federal questions that can only be resolved by this Court.

CONCLUSION

For these reasons, a writ of certiorari should issue to review the judgment, opinion and order of January 5, 1989 of the U.S. Court of Appeals for the Federal Circuit in this case.

Respectfully submitted:

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APPENDIX A

CAFC's Opinion of January 5, 1989
on the **Patent** Issues

(as reported in the
United States Patents Quarterly)

COURT OF APPEALS FOR THE FEDERAL CIRCUIT

87-1115, -1139

LEONARD JULIEN,

Plaintiff-Appellant,

v.

HENRY ZERINGUE, ZERINGUE'S FARM EQUIPMENT SERVICE, and JOHN CLET LANDRY

Defendants/Cross-Appellants,

and

THOMSON INTERNATIONAL, INC., LABADIEVILLE MACHINERY CO., INC., and ROBERT BOURDREAUX,

Defendants-Appellees.

C. Emmett Pugh, of New Orleans, Louisiana, submitted for plaintiff-appellant.

E. Richard Zamecki, Browning, Bushman, Zamecki & Anderson, of Houston, Texas, submitted for defendants/cross-appellants. Walter R. Brookhart, Browning, Bushman, Zamecki & Anderson, of Houston, Texas, of counsel.

John M. Coman, Jr., of New Orleans, Louisiana, submitted for defendants-appellees.

Appealed from: United States District Court for the Eastern District of Louisiana, Judge Collins

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DECIDED: January 5, 1989

[beginning of Appen. A, p. "1" (PQ p. 1552)]

Before BISSELL, ARCHER and MICHEL, Circuit Judges.

BISSELL, Circuit Judge.

The judgment of the United States District Court for the Eastern District of Louisiana, Civil Action Nos. 82-0673, 83-2267 (Collins, J. Nov. 19, 1986), holding Julien's U.S. Patent No. 3,286,858 ('858) not invalid and not infringed, is affirmed-in-part and vacated-in-part. In an order issued concurrently with this opinion we sanction Julien's counsel for his reckless disregard of his duties to this court and award Henry Zeringue, Zeringue's Farm Equipment Service and John Clet Landry (collectively Zeringue) and Thomson International, Inc., Labadieville Machinery Co., Inc., and Robert Bourdreaux (collectively Thomson) damages in **[beginning of Appen. A, p. "2"**

(PQ p. 1553)] the nature of attorney fees and expenses incurred on this appeal. Julien v. Zeringue, Nos. 87-1115, -1139 (Fed. Cir. Jan. 5, 1989).

BACKGROUND

Prior to 1964, the Louisiana sugar industry had successfully mechanized almost all of the agricultural aspects of the sugar cane industry, including the ground preparation, loading, transporting, ground finishing, harvesting, and unloading of the cane. Only the planting operation was still accomplished by hand. Although mechanization of the cane planting had been attempted by many well-funded researchers, no one had solved the problem of how to carefully meter out whole cane stalks, approximately 6 to 8 feet long and somewhat irregular in length, and then properly plant in an over-lapped fashion.

Julien, a farmer in Modeste, Louisiana, developed the first fully mechanized practi-

cal planter of whole Louisiana sugar cane and for his efforts received U.S. Patent No. 3,286,858. The Julien patent discloses and claims a planter for whole sugar cane which, unaided by human hands, picks up each cane stalk stacked in the wagon and properly plants it in the furrow. In operation, the cane planter is suspended above and mounted to an open-topped wagon stacked with cane stalks ready for planting. The planter uses a number of staggered parallel moving cane grabs on an endless conveyor to non-destructively grab the top-most stalk and pull it off the back of the wagon into a rear V-shaped trough. As the wagon moves along the ground, the trough guides and positions the cane as it falls down along the centerline of the furrow. Thus, regardless of where the cane is picked up by the cane grabs, the trough guides the falling cane over the center line and into the furrow.

In 1982, Julien filed suit against Zeringue for infringement of the '858 patent and later filed a separate infringement suit against Thomson. After consolidation of the two actions and a bench trial, the district court issued a memorandum opinion (1) holding claims 1-10 of the '858 patent not invalid, (2) finding that none of Zeringue's or Thomson's planters infringed claims 1, 3, 6-9 of the '858 patent, and (3) denying Julien's request for damages, attorney fees, costs, and expenses. Julien v. Zeringue, Civ. Nos. 82-0673, 83-2267 slip op. at 19-24 (E.D. La. Nov. 17, 1986). Final judgment was subsequently entered on November 19, 1986, from which both Julien and Zeringue appeal.

OPINION

1. Infringement

Julien admits that literal infringement is not at issue. In finding no infringement under the doctrine of equivalents, the

district court required the presence of each claim limitation in the accused planters. Julien argues that the district court could ignore claim limitations and merely compare the claimed invention's overall operation and ideology with the accused planters. This argument is without merit.

The district court made extensive findings regarding noninfringement of the accused planters and found that numerous claim limitations were not present in the accused planters. If a claim limitation or its substantial equivalent is not present, there can be no infringement. Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 934-35, 4 USPQ2d 1737, 1739-40 (Fed. Cir. 1987) (in banc), cert. denied, 108 S. Ct. 1226 and 1474 (1988); Lemelson v. United States, 752 F.2d 1538, 1551, 224 USPQ 526, 533 (Fed. Cir. 1985). Julien also contends that each claim limitation is present in the accused planters and that the district

court's findings to the contrary are clearly erroneous. Julien's contentions are not persuasive.

For example, Claim 1 of the '858 patent calls for

> grab means being adapted to open and close in a direction transverse to said predetermined path, means biassing [sic] said grab means to its closed position, expander means on said sub-frame positioned to temporarily open said grab means at a cane pick-up point near one end of said sub-frame and at a cane release point near the other end of said sub-frame.

'858 patent, column 2. The district court construed this language as calling for the cane grab to open and close in some manner, thereby picking up and transporting the cane stalk from the wagon to the trough. Julien, Civ. No. 82-0673, 83-2267, slip op. at 7-8, 12-16. By contrast, the accused planters use "V" or "W"-shaped rakes that engage and

transport the cane by stabbing it and raking it down into the trough. The district court found that none of the alleged infringing devices included grab means adapted to open and close, or their equivalent. Id., slip op. at 15 (findings of fact 56-64). Julien has failed to convince us that the district court's findings are clearly erroneous. See Great Northern Corp. v. Davis Core & Pad Co., 782 F.2d 159, 166, 228 USPQ 356, 359 (Fed. Cir. 1986) (finding of equivalence is one of fact reviewable under the clearly erroneous standard). Thus, a claim limitation, both **[beginning of Appen. A, p. "3" (PQ p. 1554)]** literally and equivalently, is missing and there can be no infringement. See Pennwalt, 833 F.2d at 935, 4 USPQ2d at 1740; Lemelson, 752 F.2d at 1551, 224 USPQ at 533 (Fed. Cir. 1985).

II. Validity

Zeringue asserts on cross-appeal that the district court erred in upholding the

validity of the '858 patent. Because we affirm the district court noninfringement finding, we need not reach the validity issue. See Fonar Corp. v. Johnson & Johnson, 821 F.2d 627, 634, 3 USPQ2d 1109, 1114 (Fed. Cir. 1987), cert. denied, 108 S. Ct. 751 (1988).

III. Other Matters

Julien argues on appeal that the district court erred in denying damages, attorney fees, costs, expenses and prejudgment interest. Julien's position is without merit because he failed to prevail on the infringement issue.

Zeringue argues that Julien's appeal is frivolous because it ignores controlling precedent and mistates the law. See Fed. R. App P. 38. Although Julien's counsel has encountered great difficulties preparing and prosecuting this appeal for his client resulting in great inconvenience to Zeringue,

Thomson and this court, we cannot say the appeal was frivolous on the merits.

CONCLUSION

For the foregoing reasons the judgment of the district court that claims 1, 3, 6-9 of the '858 patent are not infringed is affirmed. The judgment that Zeringue had not proven claims 1-10 invalid is vacated. All other aspects of the judgment are affirmed.

COSTS

Zeringue and Thomson are awarded costs.

AFFIRMED-IN-PART and VACATED-IN-PART

APPENDIX B

CAFC's Order of January 5, 1989
re **Sanctions**

(as reported in the
United States Patents Quarterly)

COURT OF APPEALS FOR THE FEDERAL CIRCUIT

87-1115, -1139

LEONARD JULIEN,

Plaintiff-Appellant,

v.

HENRY ZERINGUE, ZERINGUE'S FARM EQUIPMENT SERVICE, and JOHN CLET LANDRY

Defendants/Cross-Appellants,

and

THOMSON INTERNATIONAL, INC., LABADIEVILLE MACHINERY CO., INC., and ROBERT BOURDREAUX,

Defendants-Appellees.

C. Emmett Pugh, of New Orleans, Louisiana, submitted for plaintiff-appellant.

E. Richard Zamecki, Browning, Bushman, Zamecki & Anderson, of Houston, Texas, submitted for defendants/cross-appellants. Walter R. Brookhart, Browning, Bushman, Zamecki & Anderson, of Houston, Texas, of counsel.

John M. Coman, Jr., of New Orleans, Louisiana, submitted for defendants-appellees.

Appealed from: United States District Court for the Eastern District of Louisiana, Judge Collins

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DECIDED: January 5, 1989

[begin Appen. B, p. "2" (PQ p. 1555)]

Before BISSELL, ARCHER and MICHEL, Circuit Judges.

BISSELL, Circuit Judge.

O R D E R

Initially, this court dismissed the appeal of Leonard Julien (Julien) for failure to prosecute and the cross-appeal of Henry Zeringue, Zeringue's Farm Equipment Service and John Clet Landry (collectively Zeringue) as moot. Julien v. Zeringue, Nos. 87-1115, -1139 (Fed. Cir. Sept. 6, 1988) (unpub. order). The September 6 order also directed Julien and his counsel, C. Emmett Pugh, to pay as damages the reasonable attorney fees of Zeringue, and Thomson International, Inc., Labadieville Machinery Co., Inc., and Robert Bourdreaux (collectively Thomson) in this appeal, and double

costs. Julien requested reconsideration of the order, and on December 7, 1988, this court issued an unpublished order vacating the September 6 order and granting Julien's request to dispose of this appeal on the merits. Disposition on the merits occurs in an opinion issued concurrently with this order. See Julien v. Zeringue, Nos. 87-1115, -1139 (Fed. Cir. Jan. 5, 1989). Here we consider counsel's conduct, whether sanctions should be imposed, and the amount of any damages. Because Julien's counsel has demonstrated a reckless disregard for his duties to this court, we impose sanctions against C. Emmett Pugh. We award damages of reasonable attorney fees and expenses to Zeringue and Thomson.

BACKGROUND

Since December 16, 1986, when this appeal was first docketed, Julien has filed no less than 14 motions for extensions of time. Julien has met only one deadline

imposed by the rules and orders of this court.

Julien's appeal brief was originally due on February 14, 1987. On February 2, April 23, and June 1, Julien filed unopposed motions for extensions of time to file his brief. On July 20, 1987, this court informed the parties that Julien's brief was due no later than August 31, 1987. On September 1, one day after the deadline, Julien filed a motion for another extension, until September 8, to file his brief. The court granted the motion. On September 9, Julien submitted his brief accompanied by a motion for leave to file the brief one day out of time. That motion was also granted. Shortly thereafter, Zeringue and Thomson moved to strike Julien's brief and to dismiss the appeal or, in the alternative, to direct Julien to file a corrected brief. Zeringue and Thomson were both experiencing difficulties in preparing their briefs

because of Julien's failure to properly designate material for the joint appendix and to serve a table of appendix page numbers. Julien moved for and was granted an extension of time to respond to the motion. After reviewing the submissions, the court issued an order explaining in detail the proper procedure for preparing a joint appendix. The order directed Julien to serve a table of appendix page numbers and a corrected brief by November 4, 1987, and admonished Julien for not following the court's rules of practice governing the preparation of a joint appendix.

Julien did not meet the November 4 deadline. Instead, he requested and received four additional 30-day extensions of time to file his corrected brief and table of appendix page numbers. When this court granted the last extension, it warned Julien that no further extensions of time would be granted. Julien met this deadline.

Julien's reply brief and the joint appendix were due on May 19, 1988. See Fed. R. App. P. 31. On May 24, Julien moved for an extension of time, until June 6, 1988, to file his reply brief. We granted the motion on June 1, with the warning that no further extensions would be granted. Julien to date has not filed a reply brief.

In the meantime, oral argument had been set for September 8, 1988. Nine days before the scheduled argument and almost three months overdue, the court received, but rejected, Julien's joint appendix because it was delivered without a motion to file out of time. On September 2, 1988, Zeringue filed a motion to dismiss Julien's appeal for failure to timely file a joint appendix. This court granted Zeringue's motion to dismiss and awarded reasonable attorney fees against Julien because the appeal was frivolous under Federal Rule of Appellate Procedure 38. Julien v. Zeringue, Nos. 87-1115,

-1139 (Fed. Cir. Sept. 6, 1988) (unpub. order).

On September 20, 1988, Julien's counsel filed a motion for additional time to prepare his request for reconsideration. See Fed. Cir. R. 45 (providing that a motion for reconsideration must be filed "within 14 days of receiving the order of dismissal"). Julien was given until September 28, 1988, however, he was warned "[N]o additional extensions will be granted." Julien v. Zeringue, Nos. 87-1115, -1139 (Fed. Cir. Sept 22, 1988) (un-**[beginning of Appen. B, p. "3" (PQ p. 1556)]**pub. order). On September 28 and 29, Julien requested additional one-day and two-day extensions of time. Finally on October 3, 1988, Julien filed a "Petition for Reconsideration." For purposes of this appeal we treat the petition filed as a motion. See Fed. Cir. R. 45 (providing that reconsideration of dismissal is sought by motion). Julien's motion for

reconsideration contained an extensive discussion regarding the merits of the case and why counsel's poor management of this appeal was excusable and should not be sanctioned.

After reviewing Julien's motion for reconsideration, we issued an order providing, inter alia, that (1) Julien could file the joint appendix out of time, (2) Julien's motion for reconsideration of the court's September 6, 1988, dismissal order was granted, (3) the September 6, 1988, order was vacated and the mandate recalled, and (4) the court would consider the merits of the appeal and cross-appeal on the briefs. Julien v. Zeringue, Nos. 87-1115, -1139 (Fed. Cir. Dec. 7, 1988) (unpub. order).

DISCUSSION

I. Failure to Prosecute

The Federal Rules of Appellate Procedure, as supplemented by the local rules of this court, set forth certain requirements

that litigants are expected to following in pressing appeals before this court. Fed. R. App. P. 1(a), 47; see Kushner v. Winterthur Swiss Ins. Co., 620 F.2d 404, 405 (3d Cir. 1980). We want to make it very clear that our dismissal of Julien's appeal for failure to prosecute, in the first instance, was warranted and within our powers. See Fed. Cir. R. 45; Link v. Wabash R.R., 370 U.S. 626, 629 (1962). However, after considering counsel's candid admissions of fault and acknowledging the lack of a published order of this court on dismissal for failure to prosecute, we refrained from dismissing the appeal. The bar is now on notice, however, that failure to comply with this court's rules, including the requirements for preparing and filing briefs, appendices and other papers, may result in dismissal of an appeal for failure to prosecute. Fed. Cir. R. 45; see National Hockey League v. Metropolitan Hockey Club, Inc., 427 U.S. 639

(1976) (affirming a dismissal under Fed. R. Civ. P. 37 for failure to respond to interrogatories, notwithstanding the district court's admonitions and numerous extensions); Barber v. American Sec. Bank, 841 F.2d 1159, 1162 (D.C. Cir. 1988) ("Counsel's failure to file his brief on time and his failure to file the proper motions evidence inexcusable disregard for the rules of this court and thus warrant dismissal.")

If the judicial process is to function effectively, we must retain the ability to control our docket and dismiss cases where counsel fail to perform their duties. See Thermocycle Int'l Inc. v. A.F. Hinrichsen Sales Corp., 851 F.2d 339, 341, 7 USPQ2d 1407, 1408 (Fed. Cir. 1988); cf. Landis v. North Am. Co., 299 U.S. 248, 254-55 (1936) (noting that the power to stay proceedings is incidental to a court's inherent power to control its docket). Julien's counsel has repeatedly demonstrated a callous disregard

for his responsibility to meet the time deadlines imposed by his court's rules and orders. Cf. Stotler and Co. v. Able, 837 F.2d 1425, 1427 (7th Cir. 1988) ("Orders fixing the schedule for briefing an appeal must be obeyed if the business of the federal courts is to be conducted with appropriate dispatch, and we take violations of such orders seriously."). Accordingly, dismissal of Julien's appeal for failure to prosecute was warranted and dismissal will be imposed in future appeals under the proper circumstances. See Kushner, 620 F.2d at 407 (dismissing an appeal for failure to file an appendix conforming to local rules); Barber, 841 F.2d at 1162 (dismissing an appeal for appellant's failure to timely file a brief).

II. Sanctions

Julien's counsel concedes that his unprofessional management over the preparation of this appeal resulted in "burdening the appellate court with 'ragtag' and 'rough

edge' performances with hurried work products." We agree and sanction him personally under 28 U.S.C. Section 1927 (1982). Braley v. Campbell, 832 F.2d 1504, 1512 (en banc) (10th Cir. 1987); cf. Roadway Express, Inc. v. Piper, 447 U.S. 752, 764-67 (1980) (discussing availability of attorney sanctions under section 1927); see generally Martineau, Frivolous Appeals: The Uncertain Federal Response, 1984 Duke L.J. 845. Section 1927 provides that any attorney "who so multiplies the proceedings in any case unreasonably and vexatiously may be required by the court to satisfy personally the excess costs, expenses, and attorneys' fees reasonably incurred because of such conduct."

However, "[b]efore sanctioning under section 1927, the court" must give the attorney notice and opportunity to be heard. H.R. Rep. No. 1234, 96th Cong., 2d Sess. 8, reprinted in 1980 U.S. Code Cong. & Ad. News

2781, 2783 (dictating that "the court is to afford the attorney all appropriate protections of due process available under the **[beginning of Appen. B, p. "4" (PQ p. 1557)]** law."); see also Roadway Express, 447 U.S. at 767. If the court intends to sanction an attorney sua sponte, due process is satisfied by issuance of an order to show cause why sanctions should not be imposed and by providing an opportunity to respond. Braley, 832 F.2d at 1515. Due process, however, is a flexible concept and the particular procedural safeguards required will vary depending upon all the circumstances. Morrissey v. Brewer, 408 U.S. 471, 481 (1972); Braley, 832 F.2d at 1514.

Here Julien's counsel has received the process due. After receiving the September 6 dismissal order (now vacated), Julien's counsel filed extensive papers with this court providing detailed explanation as to why his conduct in preparing this appeal

should be excused, the appeal reinstated, and the sanctions lifted. Julien's motion for reconsideration was 52 pages in length and was accompanied by numerous affidavits. The motion papers asserted that the appeal was meritorious, and that if anybody was to be punished, it should be counsel and not his client Julien. The penalty suggested in that eventuality was a two-year suspension. We conclude that counsel received sufficient notice that the court was considering sanctions, and was given a subsequent opportunity to respond.

Personal sanctions under section 1927 against an attorney are appropriate for conduct that "viewed objectively, manifests either intentional or reckless disregard of the attorney's duties to the court." Braley, 832 F.2d at 1512. The judicial process has been badly abused by Julien's counsel. For example, he continually missed deadlines, requested at least 10 extensions of

time to file his briefs, and submitted a joint appendix 11 months after he was given extensive and explicit instructions on how to prepare and file a joint appendix. After being warned that no further time extensions would be granted, he missed the deadline for filing Julien's reply brief and joint appendix.

Furthermore, counsel informed this court in an October 3, 1988, affidavit that "the Julien case [was] the last piece of significant litigation for which he had any responsibility." This representation is false, counsel had another appeal (Pan American Life Insurance Co. v. Federated Mutual Insurance Co., No. 88-1536) pending before this court at the same time. On October 5, in Pan American, counsel requested a six-week extension of time to file a brief because he did not realize the brief was already overdue. This court gave counsel until October 21 to file the brief and

then dismissed the appeal for failure to prosecute when he failed to comply. Pan American, No. 88-1536 (Fed. Cir. October 27, 1988) (unpub. order). Counsel's abuse of the judicial process must come to an end. His overall pattern of conduct demonstrates a reckless disregard for his duties to this court. That conduct has unreasonably and vexatiously burdened this court and his opponents.

Counsel urges that we suspend him from appearing before this court for two years rather than assess money damages. For the present we decline to prescribe that penalty. Instead, we impose personally on Julien's counsel a portion of the attorney fees and expenses of Zeringue and Thomson, as damages. We do not impose such sanctions lightly. See Limerick v. Greenwald, 749 F.2d 97, 101-02 (1st Cir. 1984).

III. Excess Fees

After this court dismissed the appeal on September 6 (now vacated), Zeringue and Thomson filed detailed applications for attorney fees and expenses requesting $57,-220 and $6,400, respectively. Julien's counsel filed three responsive papers opposing the fee applications. The total amounts requested by Zeringue and Thomson are inappropriate under section 1927 as a sanction against Julien's counsel. Section 1927 only requires that C. Emmett Pugh pay personally the excess costs, expenses, and attorney fees reasonably incurred on this appeal as a result of his improper conduct. See S & D California Fruit Exchange, Inc. v. Gurino, 783 F.2d 345, 347 (2d Cir. 1986); cf. Roadway Express, 447 U.S. at 756 n.3 (agreeing with lower court that section 1927 provides only for excess costs and not for the total cost of the appeal). Zeringue and Thomson are entitled to reasonable attorney fees for the extra work incurred as a result of

Pugh's abuse of the judicial process. After careful review, we conclude that the amount of such attorney fees is as follows:

Zeringue	$12,087
Thomson	1,350

Accordingly, IT IS ORDERED THAT:

1. Julien's counsel, C. Emmett Pugh, is sanctioned and directed to personally pay Zeringue and Thomson damages in the nature of the extra attorney fees and expenses they incurred in this appeal.
2. Zeringue is entitled to recover the sum of $12,087.
3. Thomson is entitled to recover the sum of $1,350.

FOR THE COURT

Date

Jean Galloway Bissell
Circuit Judge